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OFFICE OF PETITIONS

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SANTA MONICA CA 90404

In re Patent No. 7,502,641	: DECISION ON REQUEST
Issued: March 10, 2009	: FOR RECONSIDERATION
Application No. 10/520,489	: OF PATENT TERM ADJUSTMENT
Filed: January 6, 2005	: AND
Attorney Docket No: 120078.010201	: NOTICE OF INTENT TO ISSUE
US. 1	: CERTIFICATE OF CORRECTION

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(D) filed on May 8, 2009 in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008). On January 15, 2010 an UPDATED SUBMISSION FOR REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(D), was filed January 15, 2010 in light of the Court of Appeals for the Federal Circuit's decision in Wyeth v. Kappos, 2009-1120 (Fed. Cir. 1-7-2010). Applicant requests that the determination of patent term adjustment be corrected from 168 days to 209 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two hundred eight (208) days is **GRANTED** to the extent indicated herein.

It is undisputed that the period of examination delay, "A" delay", pursuant to 37 CFR 1.702(a)(1) is 342 days. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on January 7, 2008, the date the national stage commenced under 35 U.S.C. 371(f), and ends on April 6, 2008, the day before the RCE was filed, the B delay is 90 days, not 91 days. See 35 U.S.C. 154(b)(1)(B)(i).

Applicants direct the office to the Information Disclosure Statement filed on September 24, 2007, subsequent to a reply filed on June 12, 2007 and argue that there should have been a 104 day deduction for applicant delay.

The Information Disclosure Statement filed September 24, 2007 was filed after the filing of a response to the non-Final Office Action on June 12, 2007. In this instance, the filing of the Information Disclosure Statement on September 24, 2007 is considered a failure to engage under 1.704(c)(8). The IDS was not expressly requested by the examiner nor did the IDS include a 1.704(d) statement.

37 CFR 1.704(c)(8) provides that:

the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

Pursuant to 37 CFR 1.704(c)(8) a period of reduction of 104 days counting the number of days in the period beginning on the day after the initial reply was filed, June 12, 2007 and ending on the date of filing of the last supplemental paper, the IDS filed September 24, 2007. Accordingly, a period of reduction of 104 days is being entered.

While not indicated by applicant, a review of the record reveals that the initial determination of patent term adjustment also included a reduction of 54 days for the submission of a "Miscellaneous Incoming Paper" after the Notice of Allowance. The reduction in question, after the mailing of the Notice of Allowance was a "MISCELLANEOUS COMMUNICATION IN RESPONSE TO NOTICE OF ALLOWABILITY", filed January 16, 2009 with the Issue Fee payment.

The submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section. See 37 CFR 1.704(e).

It is concluded that the patent term adjustment should not have been reduced by 54 days.

As such, the patent term adjustment is 208 days (342 "A delay days" + 90 "B delay days"- 224 applicant delay days), not 209 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two hundred eight (208) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,502,641 B2

DATED : March 10, 2009

INVENTOR(S) : Alan Breen

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (168) days

Delete the phrase "by 168 days" and insert – by 208 days--